REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested. Currently, claims 1-13 are pending in this application.

Rejection Under 35 U.S.C. §101:

Claims 1-7 and 10 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

MPEP §2106(IV)(B)(2)(b)(ii), entitled "Computer-Related Processes Limited to a Practical Application in the Technological Arts", describes statutory process claims under 35 U.S.C. §101. For such subject matter to be statutory, the claimed process must be limited to a practical application of an abstract idea or mathematical algorithm in the technological arts. A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. *AT&T Corp. v Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447 (Fed. Cir. 1999).

Section 11 of the Office Action does not appear to disagree that method claims 1-5 are limited to a practical application. In particular, section 11 states "...the method claimed in claims 1-5, while being a statutory 'process,' is not directed to a statutory subject matter because the steps performed are not concretely and tangible embodied and executed by a piece hardware,

notwithstanding their practical application...." Claims 1-5 require "a method of testing...." Claims 1-5 are clearly limited to a practical application in the technological arts. Again, the Office Action does not even express disagreement that claims 1-5 are directed to a practical application. Claims 1-5 are therefore clearly statutory.

Despite being directed to a practical application (and thus being statutory under 35 U.S.C. §101), the Office Action alleges that claims 1-5 "is not directed to a statutory subject matter because the steps performed are not concretely and tangibly embodied and executed by a piece of hardware." It appears that the Office Action's rationale misinterprets relevant case law indicating that a method is limited to a practical application when that method recites a step or act of producing something that is concrete, tangible and useful, to mean that the steps must necessarily be concretely and tangibly embodied and executed by a piece of hardware. The Office Action, however, provides absolutely no support for this requirement.

As indicated in MPEP §2106(IV)(B)(2)(b)(ii), examples of claimed statutory processes relating to computer-related processes limited to a practical application in the technological arts include the following:

> "– A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available.

> – A method of controlling parallel processors to accomplish multi-tasking of several computing tasks to maximize computing efficiency. See, e.g., *re Bernhart,* 417 F.2d 1395, 1400, 163 USPQ 1,616 (CCPA 1969).
>
> – A method of making a word processor by storing an executable word processing application program in a general purpose digital computer's memory, and executing the stored program to impart word processing functionality to the general purpose digital computer by changing the state of the computer's arithmetic logic unit when program instructions of the word processing program are executed.
>
> – A digital filtering process for removing noise from a digital signal comprising the steps of calculating a mathematical algorithm to produce a correction signal and subtracting the correction signal from the digital signal to remove the noise."

If, as apparently required by the Office Action, performed process steps being "concretely and tangibly embodied and executed by a piece of hardware, notwithstanding their practical application," is a requirement for qualifying as statutory subject matter under 35 U.S.C. §101, how then does a claim reciting "A method of controlling parallel processors to accomplish multi-tasking of several computing tasks to maximize computing efficiency" satisfy this requirement. (See the second of the four examples of statutory processes recited above) Similarly, how would the statutory claimed method of "A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available," explicitly provide steps concretely and tangibly embodied and executed by a piece of hardware as apparently required by the Office Action. Again, the Office

Action's apparent requirement that the process claims require steps performed are concretely and tangibly embodied and executed by a piece of hardware is simply not in accordance with relevant case law. If this were a requirement, how would the above recited four claims be judged as being statutory subject matter. The Office Action has completely ignored and failed to address how these four exemplary claims were determined as being statutory subject matter in its allegation that claims 1-5 of the present application is non-statutory subject matter under 35 U.S.C. §101.

Moreover, claims 1-5 are limited to, *inter alia*, "A method of testing an operational integrated software system...said method comprising the steps of: a) automatically registering each active element of said plurality of software elements in a registry." The inclusion of computer-related limitations such as a registry clearly limit the claims to a particular "computer" application.

Claims 6-7 and 10 require "means plus function" elements to be interpreted in view of the corresponding structure in the specification and equivalents thereof. Clearly, these elements are directed towards statutory subject matter.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

Rejection Under 35 U.S.C. §102:

Claims 1-13 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hinckley (U.S. '869). Applicant respectfully traverses this rejection.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Hinckley fails to disclose each element of the claimed invention. For example, Hinckley fails to disclose automatically registering each active element of software in a registry, as required by independent claims 1 and 6 and their respective dependents. Hinckley does not teach anything that would even lead one of ordinary skill in the art to provide automatic registration of a software element. Instead, Hinckley teaches automating testing based on a user-defined test specification. This is a much more onerous task.

During examination, claim limitations are afforded their broadest reasonable interpretation. However, even construing the claim limitations of automatically registering each active element of software in a registry in light of its broadest and reasonable interpretation, Hinckley fails to teach or suggest the above noted claim limitations.

The sentence bridging pages 3 and 4 of the Office Action alleges that "The claimed elements registering, active element of software, and registry will not be read into the claims but will be broadly and reasonably interpreted as configuring,

elements 212A-E of the software program (Figure 2) and storage area of test specifications, functions and histories of the test automation system 102, respectively (Figure 2)." Applicant disagrees with this allegation.

The term "registering" ordinarily means to record or register in a storage location. The term "active element of software" ordinarily means a software element that is active/running, particularly given that the claim is directed to a method of testing an operational integrated software system. Moreover, it is clear that the term "active element" is distinguished from other "software elements" in the claim. This is also supported at, for example, page 3, lines 19-26 of the originally-filed specification.

As noted above, the Office Action apparently alleges that the claimed "registering" is disclosed by Hinckley's teaching of "configuring." Col. 7, lines 6-58 of Hinckley discloses, *inter alia*, "multiple test functions 202, each configured to test one of the discrete components 212 of the software program." Accordingly, what is being configured is the multiple test functions 202, and not the discrete components 212. Accordingly, Hinckley fails to disclose automatically registering each active element of software in a registry since Hinckley's disclosure relating to configuring relates to test functions 202, and not to software program components 212 (which are alleged by the Office Action to disclose the active elements of software).

Moreover, "configuring" ordinarily means to arrange with a view to a specific application or use. However, this meaning is not the same ordinary meaning as "registering." Even further, the ordinary meaning of "configuring" clearly does not disclose "automatic registering" as explicitly recited in the claims. Indeed, the Office Action fails to even address "automatic registering."

More specifically, Hinckley (see, e.g., the abstract) describes a test automation system for performing functional tests of a software program in which the test system includes a plurality of test functions, each configured to test a discrete component of the software programs, and a user-defined test-specification associated with the program and arranged to provide state definitions which specify a desired test approach for each type of test procedure to be performed on the program. All test-specific and software program-specific data are located in the user-defined test functions.

Col. 6, lines 47-49 of Hinckley states, *inter alia*, "As noted, the user, by means of user interface 209, specifies the type of test that is to be performed by the test automation system 102," and thus echoes the teachings of Hinckley's abstract. In contrast, the present invention requires elements to be registered in a register which automatically associates registered elements with an associated test. The present invention provides an automatic test specification rather than requiring a user to define a test specification for each element. Hinckley does not

disclose or even suggest the automatic registering of "active elements" of software.

As noted above, the Office Action alleges that the claimed term "active element" is disclosed by elements 212A-E of the storage program. However, there is no disclosure of any of elements 212A-E being "active", as distinguished from other "software elements" of the claim.

Hinckley thus fails to disclose or suggest "automatically registering" (i.e., automatically recording in a memory location) each active element (i.e., each software element that is active/running) in a registry. Active elements are registered in a register which associates registered elements with an associated task. This provides an automatic test specification rather than requiring a user to define a test specification for each element, as is the case for Hinckley. (See the discussion above). Since active elements are registered and tested, the software can be continually tested in its intended operational environment. Hinckley fails to appreciate this benefit.

Accordingly, Applicant respectfully submits that claims 1-13 are not anticipated by Hinckley and respectfully requests that the rejection of these claims under 35 U.S.C. §102 be withdrawn.

Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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